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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/517,032	12/07/2004	Sergio Capurro	BA-22902	2851

7590 08/28/2008

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EXAMINER	
YABUT, DIANE D	
ART UNIT	PAPER NUMBER
3734	

MAIL DATE	DELIVERY MODE
08/28/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/517,032	CAPURRO, SERGIO	
	Examiner	Art Unit	
	DIANE YABUT	3734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07/14/2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-13* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-13* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 07/14/2008 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-2, 4-6, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Melzer** (U.S. Patent No. **5,389,103**) in view of **Villegas** (U.S. Patent No. **2,581,564**).

Claims 1-2 and 4-6: Melzer discloses an atraumatic surgical needle having two tissue penetrating and beveled needle tips **5** and comprising a tubular metal shaft having a hollow bore **35**, the shaft having a central portion that is equipped with a hole **36** on one

wall of the hollow shaft through which emerges a surgical thread that is anchored inside the needle by a knot (Figures 5-6, col. 6, lines 43-53).

Melzer discloses the claimed device except for the shaft being hollow from tip to tip with at least one of the tips being open and the external surface being cylindrical from tip to tip.

Villegas teaches a wholly tubular or cylindrical and hollow needle **10** (Figures 1-2). It would have been obvious to one of ordinary skill in the art at the time of invention to modify Melzer by having a shaft being hollow from tip to tip, as taught by Villegas, to further anchor the thread and so that the thread may be threaded, unthreaded and sterilized repeatedly within the needle (col. 2, lines 1-4).

Claim 13: Although neither Melzer nor Villegas expressly disclose the surgical thread being fixed by means of two or more anchoring techniques, it would have been obvious to one of ordinary skill in the art to further secure the thread to the needle by using more than one anchoring technique, as a person of ordinary skill would recognize that doing so would strengthen the connection between the thread and the needle.

4. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Melzer** (U.S. Patent No. **5,389,103**) in view of **Villegas** (U.S. Patent No. **2,581,564**), as applied to claim 1 above, and further in view of **Scirica** (U.S. Patent No. **5,908,428**).

Claim 3: Melzer and Villegas disclose the claimed device except for the surgical thread being anchored by pinching the needle.

Scirica teaches a needle wherein one end of the surgical thread **34** is inserted into the hole **212** of the needle and is anchored by pinching the needle (Figure 7 and col. 10, lines 21-26). It would have been obvious to one of ordinary skill in the art at the time of invention to anchor the surgical thread by pinching the needle, as taught by Scirica et al., to Villegas to effectively secure the thread simply by compression and eliminating the need for another securing mechanism.

5. Claims 7-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Melzer** (U.S. Patent No. **5,389,103**) in view of **Villegas** (U.S. Patent No. **2,581,564**), as applied to claim 1 above, and further in view of **Coplan** (U.S. Patent No. **3,918,455**).
Claims 7-11: Melzer and Villegas disclose the claimed device, including an atraumatic surgical needle with one end of the surgical thread being inserted into the hole and being anchored inside the atraumatic two-tipped needle, except for being anchored by means of a scotch, a solid bar or a portion of tube, made of metal or plastic, the caliber of which is determined by the diameter of the needle, which is pushed down inside the needle from one of the two ends.

Coplan teaches a surgical thread, emerging from one end of the needle, being inserted and anchored, or fixed, in a hole in one end of a scotch **34**, a solid bar or a portion of tube, made of metal or plastic, the caliber of which is determined by the diameter of the needle, which is pushed down inside the needle from one of the two ends (Figure 4, col. 4, lines 55-63 and col. 6, lines 60-62). Coplan teaches that the use of the scotch **34** for a suture-needle combination reduces trauma at the site of tissue

penetration and reduces hazard of suture tear-out (col. 1, lines 60-68). It would have been obvious to one of ordinary skill in the art at the time of invention to modify Melzer and Villegas by providing a scotch, which is pushed down inside the needle from one of two ends, as taught by Coplan, in order to reduce trauma at the site of tissue penetration and hazard of suture tear-out.

6. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Melzer** (U.S. Patent No. **5,389,103**) in view of **Villegas** (U.S. Patent No. **2,581,564**), as applied to claim 1 above, and further in view of **Borst** (U.S. Pub. No. **20040260145**).

Claim 12: Melzer and Villegas disclose the claimed device, including a surgical thread being inserted into an atraumatic two-tipped needle, except for the thread being fixed between the coils of a tiny spring.

Borst teaches a suture being fixed between the coils of a tiny spring (page 11, paragraph 132). It would have been obvious to one of ordinary skill in the art to fix a suture between the coils of a tiny spring, as taught by Borst, to Melzer and Villegas since it was known in the art that springs are used as flexible retaining means for sutures, threads, and cords.

Response to Arguments

7. Applicant's arguments filed 07/14/2008 have been fully considered but they are not persuasive.

8. Applicant argues that the needle of Melzer is not an atraumatic needle. However, the examiner asserts that the sharp needle tips **5** may prevent tearing in tissue, and therefore is considered atraumatic to some degree.

9. In response to applicant's argument that it would not occur to one of ordinary skill in the art to combine Melzer and Villegas, since Melzer is a stitching needle with two tips and Villegas is a single-tipped surgical needle, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. As maintained above, it would have been obvious to one of ordinary skill in the art at the time of invention to modify Melzer by having a shaft being hollow from tip to tip, as taught by Villegas, to further anchor the thread and so that the thread may be threaded, unthreaded and sterilized repeatedly within the needle (col. 2, lines 1-4).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DIANE YABUT whose telephone number is (571)272-6831. The examiner can normally be reached on M-F: 9AM-4PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Manahan can be reached on (571) 272-4713. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Diane Yabut/
Examiner, Art Unit 3734

/Todd E Manahan/
Supervisory Patent Examiner, Art Unit 3731